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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,185	11/19/2001	Klaus Oldermann	RCA 89,512	8200

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JOSEPH S. TRIPOLI
THOMSON MULTIMEDIA LICENSING INC.
2 INDEPENDENCE WAY
P. O. BOX 5312
PRINCETON, NJ 08543-5312

EXAMINER

KLIMOWICZ, WILLIAM JOSEPH

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,185

Applicant(s)

OLDERMANN ET AL.

Examiner

William J. Klimowicz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,8-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) 2,4,8,12-16 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-11, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Claim Status

Claims 2, 4, 8-16 and 18-20 are currently pending.

Claims 1, 3, 5-7 and 17 have been canceled by Applicants.

Claims 9-11, 18 and 19 have been examined on the merits, *supra*.

Claims 2, 4, 8, 12-16 and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-11 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunfield et al. (US 5,587,617).

As per claim 9, Dunfield et al. (US 5,587,617) discloses a device for rotating inside of a disk player and/or recorder (50) a disk shaped data carrier (60) having an opening around a center of said disk shaped carrier (60) - FIG. 2, said device comprising: fixing means (including flat surface of hub (317); elongated shaft (316)) for removably fixing said data carrier (60) by inserting a part of said fixing means in said opening, said fixing means comprising an elongated part (316); driving means (including 320, 344 and coils (324)) for rotating said data carrier (60)

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by acting on said fixing means (including flat surface of hub (317); elongated shaft (316)), said driving means (320, 344, 324) being at least partly mechanically connected to said disk player and/or recorder (FIG. 3), and said driving means (320, 344, 324) comprising a rotor magnet (344) mounted on said elongated part (316) (note that shaft (316) is of integral construction with (317), which mounts magnets (344)) and a stator electro-magnet (coils 324) mounted on said player and/or recorder such that said rotor magnet (344) and said stator electro-magnet (324) cooperate as an electric motor (e.g., see COL. 6, lines 43-47); and centering means (tip end of (316) which makes point contact within base (312) - FIG. 3) disposed "on" said fixing means for positioning said fixing means (including flat surface of hub (317); elongated shaft (316)) in a central position when said driving means stops driving said data carrier (since any offset of elongated tip portion within its sleeve portion of (312), naturally returns the tip of elongated portion (316) to its lowermost seating within sleeve portion (312) due to the internally inclined inner surfaces under gravity - hence a centering means).

As per claim 10, said rotor magnet (344) is repulsed at a determined distance from said stator electro-magnet by magnetic forces when said driving means (320, 344, 324) drives said data carrier (60). This is due to the electrical coils (324) being energized such that a rotating magnetic field causes magnetic poles of (344) to interact attractively and repulsively - via the known motor action).

As per claims 11 and 18, said elongated part (316) has a point contact with said player and/or recorder (through stator base (312)) such that a rotation axis (314) of said fixing means passes through said point contact - FIG. 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunfield et al. (US 5,587,617) in view of Elsing et al. (US 5,140,479).

See the description of Dunfield et al. (US 5,587,617), *supra*.

As per claim 19, Dunfield et al. (US 5,587,617) further shows wherein said centering means comprises a conical recess (recess within stator base sleeve (312)) which receives a tip shaped extremity from said fixing means (316).

With regard to claim 19, however, Dunfield et al. (US 5,587,617) does not expressly show the spindle tip elongated portion as being elastically mounted to said player and/or recorder.

Elsing et al. (US 5,140,479), however, teaches providing a spindle tip elongated portion (36) as being elastically mounted to said player and/or recorder (at 32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the elastically mounted elongated portion of the spindle, as taught by Elsing et al. (US 5,140,479) to the device of Dunfield et al. (US 5,587,617).

The rationale is as follows: one of ordinary skill in the art would have been motivated to provide the elastically mounted elongated portion of the spindle, as taught by Elsing et al. (US

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5,140,479) to the device of Dunfield et al. (US 5,587,617) in order to eliminate static charge from a disk drive spindle with greatly reduced vibration (e.g., see COL. 1, lines 64-67 of Elsing et al. (US 5,140,479)).

Response to Arguments

Applicant's arguments filed August 27, 2003 (Paper No. 8, Amendment B) have been fully considered but they are not persuasive.

Applicants allege that Dunfield et al. (US 5,587,617) does not disclose the claimed invention. The Applicants merely allege that Dunfield et al. (US 5,587,617) "discloses a completely different arrangement in which a disk is journaled about a shaft that is rotated by a spindle motor comprising a magnetic bearing assembly." See Applicants' arguments, Amendment B, at, *inter alia*, page 8 of Paper No. 8.

Applicants thus allege, that "[s]ince Dunfield et al. does not teach disposing a centering means on a fixing means for positioning the fixing means in a central position when a driving means stops a data carrier, claim 9 is patentable over Dunfield et al." *Id.*

The Examiner respectfully disagrees with the Applicants contention. Moreover, it is somewhat unclear from Applicants' arguments as to how Dunfield et al. (US 5,587,617) differs from the claimed invention, since Applicants have not articulated as to what structure, in Applicants' view, is not disclosed by Dunfield et al. (US 5,587,617). Applicants merely state that Dunfield et al. (US 5,587,617) shows a "different arrangement." In view of Applicants complete disclosure, including the drawings and complete specification, the Examiner might

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agree. However, the Examiner is charged with interpreting the claims in a broad, yet reasonable manner, and applying art to the claimed invention, not the disclosure as a whole.

Moreover, as set forth in the rejection, *supra*, the Examiner maintains that Dunfield et al. (US 5,587,617) discloses fixing means (including flat surface of hub (317); elongated shaft (316)) for removably fixing said data carrier (60) by inserting a part of said fixing means in an opening, the fixing means including an elongated part (316) and centering means (tip end of (316) which makes point contact within base (312) - FIG. 3) disposed “on” the fixing means for positioning the fixing means (including flat surface of hub (317); elongated shaft (316)) in a central position when the driving means stops driving the data carrier (since any offset of elongated tip portion within its sleeve portion of (312), naturally returns the tip of elongated portion (316) to its lowermost seating within sleeve portion (312) due to the internally inclined inner surfaces under gravity - hence a centering means). Clearly, the tip end of (316) (i.e., the centering means) is provided on the fixing means (including flat surface of hub (317); elongated shaft (316)) in as much as a wheel is considered to be provided on a car. That is, although the wheels are provided “under” the car, they are still considered by the layperson and those associated in the automotive industry as being provided “on” the car. Similarly, although the tip (316) as disclosed by Dunfield et al. (US 5,587,617) is depicted in the FIGs. as being “under” the fixing means when mounted in an upright position, the tip is still considered to be “on” the fixing means.

Note Applicants have not defined specifically the corresponding structure within their specification which corresponds to the claimed “centering means” assuming 35 USC 112 sixth paragraph has been invoked.

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Applicants have further failed to define this correspondence in their arguments, as set forth in Amendment B (Paper No. 8).

The Examiner notes that the centering means (tip end of (316) which makes point contact within base (312) - FIG. 3) and fixing means (including flat surface of hub (317); elongated shaft (316)) performs the specified function as recited in the claims and further notes that the elements as articulated, *supra*, as corresponding to Applicants' "centering means" and "fixing means" are not excluded by any explicit definition provided in the specification for an equivalent.

Pertaining to the claims rejected under 35 U.S.C. § 102 as being anticipated by the disclosure of Dunfield et al. (US 5,587,617) the following should be noted. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); *cert. dismissed*, 468 U.S. 1228 (1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 72.1 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

The Examiner, as clearly articulated in the rejection, *supra*, has set forth a one-to-one correspondence with each and every element of the *claimed* invention. More concretely, as recited MPEP§2106:

Office personnel are to give claims their ***broadest reasonable interpretation*** in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). ***Limitations appearing in the specification but not recited in the claim are not read into the claim.*** *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During

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patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. . . . The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. . . . An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”). [Emphasis in bold italics added].

Moreover, one must also bear in mind that limitations contained within Applicants’ arguments cannot be read into the claims for the purpose of avoiding prior art. *In re Sporck*, 386 F.2d 924, 155 USPQ 687 (CCPA 1968).

As set forth in the MPEP§ 706, “the standard to be applied in all cases is the “preponderance of the evidence” test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable.” Clearly, the Examiner has established that one of ordinary skill in the art would *reasonably* construe the one-to-one correspondence with each and every element of the *claimed* invention, in the manner set forth in the rejection, *supra*, by at least the *preponderance* of the evidence. The Applicants’ arguments have fallen well short of rebutting the Examiner’s *prima facie* case of anticipation.

As it pertains to the rejection of claim 19, Applicants allege that the combination of Elsing et al. (US 5,140,479) with Dunfield et al. (US 5,587,617) does not teach the claimed invention, in that Elsing et al. (US 5,140,479), as well as Dunfield et al. (US 5,587,617), each disclose ‘a completely different arrangement’ as it apparently pertains to the Applicants’ disclosure.

The Examiner again respectfully disagrees. Moreover, as noted *supra*, the Examiner is rejecting the claimed invention and not Applicants' disclosure.

As clearly set forth in the rejection, the Examiner maintains that with regard to claim 19, although Dunfield et al. (US 5,587,617) does not expressly show the spindle tip elongated portion as being elastically mounted to said player and/or recorder, such structure has been provided in the prior art to arrive at an advantageous spindle structure, thus evidencing a *prima facie* case of obviousness based on the preponderance of the evidence.

More concretely, Elsing et al. (US 5,140,479) teaches providing a spindle tip elongated portion (36) as being elastically mounted to said player and/or recorder (at 32).

Given such a desirable configuration, the Examiner maintains that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the elastically mounted elongated portion of the spindle, as taught by Elsing et al. (US 5,140,479) to the device of Dunfield et al. (US 5,587,617) in order to advantageously eliminate static charge from a disk drive spindle with greatly reduced vibration (e.g., see COL. 1, lines 64-67 of Elsing et al. (US 5,140,479)).

The Examiner maintains that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter, but simply what the combination of references makes obvious to one of ordinary skill in the art. As has been held in *In re Bozek*, 163 USPQ 545 (CCPA 1969), the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter, but simply what the combination of references makes obvious to one having ordinary skill in the pertinent art. See also *In re Mapelsden*, 51 CCPA 1123, 329 F.2d

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321, 141 USPQ 30 (1964); *In re Henley*, 44 CCPA 701, 239 F.2d 3, 112 USPQ 56 (1956); *In re Richman*, 165 USPQ 509 (CCPA 1970); *In re Van Beckum*, 169 USPQ 47 (CCPA 1971) and also *In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

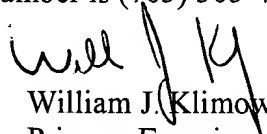
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (703) 305-3452. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.


William J. Klimowicz
Primary Examiner
Art Unit 2652

WJK
September 30, 2003